UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,285	02/06/2004	Serafim Bochkarev	1793.1114	4961

21171   7590   12/10/2008
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
NGUYEN, VAN H

ART UNIT	PAPER NUMBER
2194	

MAIL DATE	DELIVERY MODE
12/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)	
Office Action Summary	10/772,285	BOCHKAREV ET AL.	
	Examiner	Art Unit	
	VAN H. NGUYEN	2194	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>28 August 2008</u>.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-12</u> is/are pending in the application.

    4a) Of the above claim(s) <u>9-12</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-8</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is responsive to the Requirement for Restriction filed 08/28/2008.

Claims 1-12 are pending. Claims 1-8 (Group I) have been elected with traverse.

Applicant is required to cancel non-elected claims 9-12 in the next response to this office
action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the
inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the
currently named inventors is no longer an inventor of at least one claim remaining in the
application. Any amendment of inventorship must be accompanied by a request under 37
CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Election/Restrictions

2.   Applicant's election with traverse of Group I (claims 1-8) in the reply filed 08/28/2008 is
acknowledged. The traversal is on the ground(s) that the claims in the groups are not
significantly different. This is not found persuasive because of the following.

It is the examiner's opinion that there are significant differences between Group I (claims

1-8) and Group II (claims 9-12). Inventions I and II are related as subcombinations

disclosed as usable together in a single combination. The subcombinations are distinct

from each other if they are shown to be separately usable. In the instant case, invention II

has separate utility because it does not require *"receiving 16 bit dialogue window*

information of the device from the operating system; converting the received 16 bit

dialogue window information to 32 bit dialogue window information". See MPEP §

806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a

separate status in the art as shown by their different classification, restriction for

examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required

for one group is not required for the other groups, restriction for examination purposes as

indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. under 35 U.S.C. 101

Regarding independent claim 1, the language of independent claim 1 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or <u>machine</u> which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claim 1 does not appear to require any computer hardware to implement the claimed invention. These claims appear to define the metes and bounds of an invention comprised solely of software.

If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. <u>In re Schrader</u>, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994).

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." <u>State Street</u>, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1601-02 (Fed. Cir. 1998). MPEP 2106. However, <u>State Street</u> does not hold that a "useful, concrete and tangible result" alone, without a machine, is sufficient for statutory subject matter.

Dependent claims 2-3 are rejected for fully incorporating the deficiencies of their base claim.

Regarding independent claim 4, the claim recites an "apparatus" comprising "a framework". As currently recited the "apparatus" comprises only computer software element(s). Thus, the claim is a program per se and does not fall within any of the four enumerated categories of patentable subject matter in section 101.

For the same reasons discussed supra with respect to independent claim 1, dependent claims 5-7 fall outside the scope of § 101.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States
before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States
before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a)
shall have the effects for purposes of this subsection of an application filed in the United States only if the international application
designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by **Hart et al.** (US

6763518 B2).

As to claim 1:

Hart teaches (see Abstract; col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) a

method of displaying a dialogue window of a device performed by a device control

portion, the method comprising:

-   requesting an operating system supporting a 16 bit device control portion to

    display a 32 bit dialogue window for exchange of information between a user and

    a predetermined device and not a 16 bit dialog window;

-   receiving 16 bit dialogue window information of the device from the operating

    system;

- converting the received 16 bit dialogue window information to 32 bit dialogue
  window information; and

- displaying the 32 bit dialogue window corresponding to the converted 32 bit
  dialogue window information and not displaying the 16 bit dialog window.

As to claim 2:

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the
converting comprises: generating 32 bit base dialogue window information having no
content of the 32 bit dialogue window; and modifying the 16 bit dialogue window
information to the converted 32 bit dialogue window information, in response to the 32
bit base dialogue window information.

As to claim 3:

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the 16 bit
dialogue window information comprises a plurality of 16 bit dialogue window page
information and the displaying comprises displaying as the converted 32 bit dialogue
window information, converted 32 bit page information in response to a request by the
user for one of the 16 bit dialogue window page information in the 32 bit dialogue
window.

As to claim 4:

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10)an apparatus displaying a device dialogue window according to dialogue window information, the apparatus comprising:

- a first interface portion receiving 16 bit dialogue window information of the device from a first operating system supporting a 16 bit device control portion;

- a second interface portion receiving 32 bit dialogue window information of the device from a second operating system supporting a 32 bit device control portion;

- a bit converting portion converting the received 16 bit dialogue window information to converted 32 bit dialogue window information and outputting the converted 32 bit dialogue window information; and

- a dialogue window display portion displaying a 32 bit dialogue window corresponding to the converted 32 bit dialogue window information and not displaying a 16 bit dialogue window.

As to claim 5:

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the bit converting portion comprises: a base dialogue window generating portion generating a 32 bit base dialogue window information having no content of the 32 bit dialogue window and outputting the generated 32 bit base dialogue window information; and

a data modification portion modifying the received 16 bit dialogue window information

to the converted 32 bit dialogue window information and outputting the converted 32 bit

dialogue window information to the dialogue window display portion to display the 32

bit dialogue window corresponding to the converted 32 bit dialogue window information,

in response to the 32 bit base dialogue window information.

As to claim 6:

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the dialogue

window information comprises a plurality of dialogue window page information, and

wherein the dialogue window display portion displays as the converted 32 bit dialogue

window information, converted 32 bit page information or 32 bit page information, in

response to a request by a user for one of the dialogue window page information by

requesting the bit converting portion or the second interface portion to provide the

converted 32 bit page information or the 32 bit page information, respectively.

As to claim 7:

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10) the 16 bit

dialogue window information comprises a plurality of 16 bit dialogue window page

information, and wherein the bit converting portion, in response to a request by the

dialogue window display portion for a converted 32 bit dialogue window page

information as the converted 32 bit dialogue window information, requests the first

interface portion to provide one of the 16 bit dialogue window page information of the 16

bit dialogue window information, converts the requested 16 bit dialogue window page

information to the converted 32 bit page dialogue window information, and outputs the

converted 32 bit page information to the dialogue window display portion.

As to claim 8:

Hart teaches (see col.5, line 33-col.6, line 9; and col.6, line 60-col.7, line 10)machine

readable data storage storing a device driver program controlling a computer to display a

device driver dialogue window to interface with a device regardless of the number of bits

supported by the computer operating system, according to a process comprising:

- receiving a request from an operating system supporting a 16 bit device driver to
  display a 32 bit dialogue window for exchange of information between a user and
  the device and not a 16 bit dialogue window;

- receiving 16 bit dialogue window information of the device from the operating
  system;

- converting the received 16 bit dialogue window information to 32 bit dialogue
  window information; and

- displaying the 32 bit dialogue window corresponding to the converted 32 bit
  dialogue window information and not displaying the 16 bit dialog window.

Response to Arguments

5.   Applicant's arguments filed **03/07/08** have been considered but are moot in view of the
new ground(s) of rejection.

During patent examination, the pending claims must be "given their broadest reasonable
interpretation consistent with the specification." In re Hyatt 21 1 F.3d 1367, 1372, 54
USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend
the claims during prosecution, and broad interpretation by the examiner reduces the
possibility that the claim, once issued, will be interpreted more broadly than is justified.
In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See also In
re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (1989) "During patent
examination the pending claims must be interpreted as broadly as their terms reasonably
allow.... The reason is simply that during patent prosecution when claims can be
amended, ambiguities should be recognized, scope and breadth of language explored, and
clarification imposed.... An essential purpose of patent examination is to fashion claims
that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of
claim scope be removed, as much as possible, during the administrative process."

Applicant should set forth claims in language that clearly, distinctly, unambiguously, and
uniquely define the invention.

Conclusion

6.   The prior art made of record, see PTO 892, and not relied upon is considered pertinent to

applicant's disclosure. Applicant should review these references carefully before

responding to this office action.

Contact Information

7.   Any inquiry or a general nature or relating to the status of this application should
be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to VAN H. NGUYEN whose telephone number is (571)
272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM-
6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, MENG-AI AN can be reached at (571) 272-3756.

The fax phone number for the organization where this application or proceeding is
assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published
applications may be obtained from either Private PAIR or Public PAIR. Status
information for unpublished applications is available through Private PAIR only. For
more information about the PAIR system, see http://pair-direct.uspto.gov. Should you
have questions on access to the Private PAIR system, contact the Electronic Business
Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO
Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VAN H NGUYEN/
Primary Examiner, Art Unit 2194